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EXAMINER

PHAN, TAM T

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,138

Applicant(s)

MALIK, DALE W.

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-8, 15 and 21-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 15 and 21-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application has been examined. Amendment received on 09/23/2004 has been entered. Claims 1, 15, and 21 are currently amended. Claims 4-5, 9-14, 16-20, 24-25, and 29 are cancelled. Claims 30-42 are newly added.
2. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are presented for examination.

Priority

3. No priority claims have been made.
4. The effective filing date for the subject matter defined in the pending claims in this application is 12/29/2000.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 35-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter of a "computer readable medium per se". Computer readable medium per se are not patentable.
7. For examining purposes, "A computer readable medium for managing a user's electronic mailbox on a computer" in claims 35-42 will read as "A computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox" to allow the claim to be examined with respect to the prior art.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848) in view of Jungck (U.S. Patent Number 6,728,785).

10. Regarding claim 1, Arnold disclosed a method for automatically managing an electronic mail server application on a host computer, comprising the steps of: checking an electronic mail message against a predetermined criteria; and compacting the electronic mail message if the predetermined criteria is satisfied (Abstract, Figure 2, column 2 lines 42-50, column 3 lines 39-56, column 4 lines 6-23).

11. Arnold taught the invention substantially as claimed. However, Arnold did not expressly teach compacting a non-attachment portion of the electronic mail message.

12. Arnold suggested exploration of art and/or provided a reason to modify the managing electronic mail method with additional feature such as compacting the content of the electronic message (column 1 lines 26-37, column 1 line 63-column 2 line 13).

13. Jungck disclosed a method for managing electronic messages wherein the attachment and non-attachment portion of the electronic message is compacted (column 4 lines 1-12, column 5 lines 37-42, column 6 lines 27-37).

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14. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Arnold with the teachings of Jungck to include the message content compaction feature in order to reduce the size of the message so that file transfers will be more efficient (Jungck, column 3 line 66-column 4 line 3) since transfer speed of the files over the Internet is a critical factor in the usability of the Internet (Jungck, column 3 lines 65-66).

15. Regarding claim 2, Arnold disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application [message switch] (Figures 1-2, column 2 lines 27-37, column 3 lines 45-50).

16. Regarding claim 3, Arnold disclosed a method wherein the step of checking is performed periodically on the host computer (column 2 lines 42-50, column 4 lines 9-19).

17. Regarding claim 6, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 12-19).

18. Regarding claim 7, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size [configurable factors] (column 1 lines 45-57, column 4 lines 12-17, lines 64-67).

19. Regarding claim 8, Arnold disclosed a method wherein the predetermined criteria comprise an attachment type [configurable factors] (column 5 lines 16-18, column 4 lines 12-17).

20. Regarding claim 15, Arnold disclosed a method further comprising the step of compressing the attachment (column 1 lines 38-41).

21. Regarding claim 21, Arnold and Jungck combined disclose a method for managing a user's electronic mailbox on a computer, comprising the steps of: checking an electronic mail

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message against a predetermined criteria (Arnold, Abstract, Figure 2, column 2 lines 42-50, column 3 lines 39-56, column 4 lines 6-23); and compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns (Arnold, Figure 2, column 4 lines 6-23; Jungck, column 3 lines 6-12, column 4 lines 1-12, column 5 lines 37-42, column 6 lines 27-37).

22. Regarding claim 22, Jungck disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox [data center] (column 6 lines 13-26).

23. Regarding claim 23, Arnold disclosed a method wherein the step of checking is performed upon request by the user (column 2 line 56-column 3 line 2, column 4 lines 58-67).

24. Regarding claim 26, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 6-23).

25. Regarding claim 27, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size (column 4 lines 6-24).

26. Regarding claim 28, Arnold disclosed a method wherein the predetermined criteria comprises an attachment type (column 4 lines 6-24).

27. Regarding claim 30, Jungck disclosed a method wherein the location of the screening of the message is on a server (column 6 lines 27-37).

28. Regarding claim 31, Jungck disclosed a method wherein the location of the screening of the message is on a client (column 4 lines 34-47).

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29. Regarding claim 32, Arnold disclosed a method wherein the location of the screening of the message is configured by a user (column 2 line 56-column 3 line 2, column 4 lines 58-67).

30. Regarding claim 33, Arnold disclosed a method wherein the screening is performed periodically on the computer (column 6 lines 13-33).

31. Regarding claim 34, Jungck disclosed a method wherein the electronic mail message is compressed into a zipped file (column 1 lines 18-26).

32. Regarding claims 35-42, the computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox corresponds directly to the method of claims 21-23, 26-8, and 30-34, and thus these claims are rejected using the same rationale.

33. Since all the limitations of the claimed invention were disclosed by the combination of Arnold and Jungck, claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected.

34. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (U.S. Patent No. 6,275,850), hereinafter referred to as Beyda, in view of Gage et al. (U.S. Patent Number 5,923,846), hereinafter referred to as Gage.

35. Regarding claim 1, Beyda disclosed a method for automatically managing an electronic mail server application on a host computer, said method comprising the steps of checking an electronic mail message against a predetermined criteria (Figure 3, column 2 lines 42-63).

36. Beyda taught the invention substantially as claimed. However, Beyda did not expressly teach compacting a non-attachment portion of the electronic mail message if the predetermined criterion is satisfied.

37. Beyda suggested exploration of art and/or provided a reason to modify the method with the compacting the electronic message to minimize downloading time (Figure 3, column 1 lines 49-55).

38. Gage disclosed a method for managing electronic messages wherein the attachment and non-attachment portions of the electronic mail message are compacted (Figures 5 and 7, column 12 line 51-column 13 line 7, column 13 line 59-column 14 line 2, column 14 lines 30-41).

39. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Arnold with the teachings of Gage to include the non-attachment compaction feature in order to reduce the size of the message so that file transfers will be more efficient (Gage, column 13 lines 2-7) since the non-attachment portion of the electronic message might contains many internal codes that represent font descriptions, font changes, tab settings, etc. (column 12 line 63-column 13 line 7).

40. Regarding claim 2, Beyda disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23).

41. Regarding claim 3, Beyda disclosed a method wherein the step of checking is performed periodically on the host computer (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23).

42. Regarding claim 6, Beyda disclosed a method wherein the predetermined criteria comprise a total message size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

43. Regarding claim 7, Beyda disclosed a method wherein the predetermined criteria comprise an attachment size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

44. Regarding claim 8, Beyda disclosed a method wherein the predetermined criteria comprise an attachment type (Figure 3 sign 62, column 2 lines 51-63, column 3 lines 4-13).

45. Regarding claim 15, Gage disclosed a method further comprising the step of compressing the attachment (Figure 5).

46. Regarding claim 21, Beyda and Gage combined disclose a method for managing a user's electronic mailbox on a computer, comprising the steps of: checking an electronic mail message against a predetermined criteria (Beyda, Figure 3, column 2 lines 42-63); and compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns (Gage, Figures 5 and 7, column 12 line 51-column 13 line 7, column 13 line 59-column 14 line 2, column 14 lines 30-41).

47. Regarding claim 22, Beyda disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox (Figure 3, column 5 line 59-column 6 line 5).

48. Regarding claim 23, Beyda disclosed a method wherein the step of checking is performed upon request by the user (column 4 lines 45-61, column 6 lines 35-49).

49. Regarding claim 26, Gage disclosed a method wherein the predetermined criteria comprises a total message size (column 2 lines 10-24, column 12 line 51-column 13 line 9).

50. Regarding claim 27, Beyda disclosed a method wherein the predetermined criteria comprises an attachment size (Abstract, Figure 3, column 3 lines 4-13).

51. Regarding claim 28, Beyda disclosed a method wherein the predetermined criteria comprises an attachment type (Abstract, Figure 3, column 3 lines 4-13).
52. Regarding claim 30, Beyda disclosed a method wherein the location of the screening of the message is on a server (Figure 3, column 5 line 59-column 6 line 5).
53. Regarding claim 31, Gage disclosed a method wherein the location of the screening of the message is on a client (column 13 lines 59-66, column 14 lines 30-41)
54. Regarding claim 32, Beyda disclosed a method wherein the location of the screening of the message is configured by a user (column 6 lines 35-49, column 7 lines 23-29, lines 40-45).
55. Regarding claim 33, Beyda and Gage disclosed a method wherein the screening is performed periodically on the computer (Beyda, Figure 3, column 3 lines 31-35; Gage, column 17 lines 44-54).
56. Regarding claim 34, Gage disclosed a method wherein the electronic mail message is compressed into a zipped file (column 6 lines 32-38, column 10 lines 44-55, column 11 lines 23-27).
57. Regarding claims 35-42, the computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox corresponds directly to the method of claims 21-23, 26-8, and 30-34, and thus these claims are rejected using the same rationale.
58. Since all the limitations of the claimed invention were disclosed by the combination of Beyda and Gage, claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected.

Response to Arguments

59. Applicants' arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

60. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Conclusion

61. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

62. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

63. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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tp
January 21, 2005

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